

**REMARKS**

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1, 3-8, 11 and 15-46 are pending in this application. Claims 1, 3-8, 11 and 15-18 are amended. Claims 2, 9, 10 and 12-14 are canceled by this response. Claims 19-46 are new.

**Provisional Double Patenting Rejections**

Claims 1-18 stand provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/759,460. Applicants acknowledge this provisional rejection, and will take the appropriate steps to address this rejection once the claims in the present application and the claims in pending application No. 10/759,460 are indicated as including allowable subject matter since this provisional rejection is based on claims that may change. Further, Applicants respectfully request the Examiner reconsider this rejection in view of the amended claims. Moreover, Applicants respectfully submit claims 1-18 of the current application and claims 1-22 of copending Application No. 10/759,460 are patentably distinct, as detailed below.

Applicants submit that to establish a *prima facie* case of nonstatutory-type double patenting rejection, the Examiner must first identify the inventions claimed in the claims under consideration and in the reference patent claims. The Examiner must then establish that any variation between the inventions claimed in the claims under consideration and the earlier-issued patent claims would have been obvious to a person having ordinary skill in the art.

Based on U.S. case law, the Examiner's showing of obviousness must follow the analysis used to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a); the

burden of proof would then shift to the applicant to rebut the *prima facie* case. *See In re Longi*, 225 USPQ 645, 651 (Fed. Cir. 1985).

On page 3 of the Office Action, Examiner states that “although the conflicting claims are not identical, they are not patentably distinct from each other.” More specifically, Examiner states that “both inventions relate to managing reproduction of still images and related data associated with the still pictures with the related data being graphic data and subtitle data.” Further, Examiner states that “both inventions also relate to multiplexing the still image and the related associated data into transport stream and packetized elementary streams.” However, as an example, Applicants submit that claim 1 of the current application appears to be patentably distinct from claim 1 of the copending application. In particular, independent claim 1 of the current application recites *inter alia* “reproducing **audio data from a second file**” while independent claim 1 of copending application No. 10/759,460 recites *inter alia* “the related data **not including audio data**.” Therefore, it is not possible to read on both claims simultaneously. The audio data, or lack thereof, determines which claim is read upon. Therefore, at the very least, at least some of claims 1-18 of the current application and at least some of claims 1-22 of copending Application No. 10/759,460 are patentably distinct from each other. Should Examiner still find certain claims to be patentably indistinct between the two copending applications, Applicants respectfully submit that Examiner specify and explain, with respect to the obviousness standards described above, those claims of the copending applications that Examiner alleges to be patentably indistinct.

#### **Rejections under 35 U.S.C. § 101**

Claims 1-14 stand rejected under 35 U.S.C. § 101 as being directed to a recording medium storing nonfunctional descriptive material. Applicants respectfully traverse this rejection for the reasons detailed below.

The Examiner stated that the claimed invention would have been statutory if worded to include “computer program embedded in a computer readable medium”. While Applicants have amended independent claims 1 and 12 to include “computer-readable medium”, Applicants respectfully submit that the Examiner has incorrectly characterized the need for the additional language “computer program”. The Manual of Patent Examining Procedure (MPEP) provides guidance on the difference between “nonfunctional descriptive material” and “functional descriptive material”. In particular, MPEP § 2106.01 states the following.

In this context, “functional descriptive material” consists of **data structures** and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5<sup>th</sup> ed. 1993).) “Nonfunctional descriptive material” includes but is not limited music, literary works and a compilation or mere arrangement of data.

(Emphasis added.)

Accordingly, Applicants respectfully submit that “a computer-readable medium having a data structure for managing reproduction of still pictures,” as recited in amended independent claims 1 and 12 is a medium storing functional descriptive material.

MPEP §2106.01(I) further states, regarding functional descriptive material, that “a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.”

Accordingly, the computer-readable medium recited in claim 1 includes a first file, a second file, and at least one playlist. The playlist includes at least one playitem providing navigation information for reproducing at least one still picture from a first file and at least one sub-playitem providing navigation information for reproducing audio data from a second file. Therefore, claim 1 is clearly directed towards patentable, statutory subject matter.

Similarly, the computer-readable medium recited in claim 12 includes a first data stream, a second data stream, and at least one playlist file. The playlist file includes at least one playitem providing navigation information for reproducing at least one still picture from a first data stream and at least one sub-playitem for providing navigation information for reproducing an audio stream from a second data stream. Therefore, claim 12 is clearly directed towards patentable, statutory subject matter.

The Applicants, therefore, respectfully request that the rejection to Claims 1-14 under 35 U.S.C. § 101 be withdrawn. Claims 2-11 and 13-14, dependent on independent claims 1 and 12 respectively, are patentable for the reasons stated above as well as for their own merits.

#### **Rejections under 35 U.S.C. § 102**

Claims 1, 2, 11, 12, and 15-18 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hamada et al (U.S. Patent Number 6,999,674, herein Hamada). Applicants respectfully traverse this rejection for the reasons detailed below.

Initially, Applicants respectfully note that independent claims 1 and 15-18 recite *inter alia* “the playitem providing navigation information for reproducing at least one still picture from a first file” and “the sub-playitem providing navigation information for reproducing audio data from a second file.” Applicants respectfully submit that these features and relationships between these features of independent claims 1 and 15-18 patentably distinguish these claims over Hamada as detailed below.

In the art grounds of rejection, the Examiner relies on Col. 6, lines 11-18 of Hamada as disclosing the playitem providing navigation information for reproducing at least one still picture from a first file and the sub-playitem providing navigation information for reproducing audio data from a second file. However, Col. 6, lines 11-18, only concludes that a “Playlist is composed of one or more Playitems” where a Playitem is defined as a “set of

information which designates an AV stream and information representative of a start point and an end point of an AV stream.” There is no reference to having separate data files for still pictures and audio data.

Furthermore, the Examiner relies on Col. 6, lines 46-53, as disclosing a data structure for managing “still pictures.” However, Col. 6, lines 46-53 only discloses that if “discontinuity is present at a connection point of a Playitem, then such deterioration of the reproduction quality that an image reproduced becomes a still picture or an image or sound is interrupted occurs.” Restated, Hamada simply asserts that a delay in time between two files will result in the last image shown becoming a still picture or an interrupted sound. Col. 6, lines 46-53 of Hamada do not teach using separate still picture and audio data files.

Also, in Col. 2, lines 25-42, of Hamada, the Examiner relies on “AV data” as disclosing still picture files. However, as further illustrated in example embodiments in FIGS. 3, 5 and 7 of Applicants’ specification, the still image file is a separate file from the movie video or audio data file. Furthermore, example embodiments in FIGS. 5 and 7 show the PlayItem pointing to the still picture file and the SubPlayItem pointing to the audio file. Unlike Hamada, the Playitem and the SubPlayItem do not point to AV data streams as shown in Hamada at col. 6, lines 11-18.

Accordingly, Hamada fails to disclose “the playitem providing navigation information for reproducing at least one still picture from a first file” and “the sub-playitem providing navigation information for reproducing audio data from a second file” of claims 1 and 15-18.

The Examiner also relies on Hamada at Fig. 2, Col. 6, lines 17-18 and 35, as showing a “Clip”, which is alleged to disclose the element “sub-playitem” in claim 1. Hamada at Fig. 3 and Col. 6, lines 28-34, states that “An AV stream file and an AV stream information file are regarded as an object as a unit of information and is called Clip. In particular, as seen in Fig. 3, the Clip is an object composed of an AV stream file and an AV stream information file.” However, Applicant’s specification at [0031] defines sub-playitems as providing “a

pair of IN-point and OUT-point that **point to positions** on a time axis of a clip file” (Emphasis added). More specifically, the “sub-playitem **points to a clip** for or portion thereof and identifies the clip information file associated with the clip file” (Emphasis added). Therefore, the “clip” in Hamada fails to disclose the sub-playitem. In relation, the sub-playitem points to the clip, but is not actually the clip. Nonetheless, the clips in Hamada and Applicants’ specification differ in their content as Hamada has not been shown to disclose clips holding separate still picture and audio streams.

In light of the above, Applicants respectfully request the rejection of claims 1 and 15-18, and claims dependent therefrom, under 35 U.S.C. § 102(e) be withdrawn.

Further, should the Examiner maintain this rejection based on Hamada, Applicants respectfully request the Examiner identify which specific portions of Hamada are believed to correspond to the “playitem providing navigation information for at least one still picture from a first file”, and “sub-playitem providing navigation information for audio data from a second file” recited in claims 1 and 15-18.

Independent claim 12 contains features somewhat similar to claims 1, 15-18 and therefore is also patentable for the reasons stated above. Claims 2 and 11 depend from independent claim 1 and are thus patentable over Hamada for the same reasons explained above as well as on their own merits.

The Applicants, therefore, respectfully request that the rejection to Claims 1, 2, 11, 12, and 15-18 under 35 U.S.C. § 102(e) be withdrawn.

### **Rejections under 35 U.S.C. § 103**

Claims 3-6 are rejected under 35 U.S.C. § 103(e) as being unpatentable over Hamada as applied to claims 1 and 2 above, and further in view of Sako et al. (U.S. Patent Number 6,829,211, herein Sako). Claims 7-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamada and Sako as applied to claims 3-6 above, and further in view of

European Telecommunication Standard (ETS 300 743, herein ETS). Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamada as applied to claims 7-9 above, in view of Sako and ETS and further in view of Plourde, JR (U.S. Publication Number 2006/0195633, herein Plourde). Claims 13 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamada as applied to claim 12 above, and further in view of ETS. Applicants respectfully traverse these rejection for the reasons detailed below.

Applicants respectfully submit that even assuming arguendo that Hamada, Sako, ETS and Plourde are combinable (which Applicants do not admit), Sako, ETS, and Plourde fail to cure the deficiencies of Hamada as discussed above in regards to amended independent claims 1 and 12 as well as on their own merits.

The Applicants, therefore, respectfully request that the rejections to Claim 3-10, 13-14 under 35 U.S.C. § 103(a) be withdrawn.

### **NEW CLAIMS**

New claims 19-46 are dependent on one of the allowable independent claims discussed above; and therefore, are patentable at least for the reasons discussed above with respect to those dependent claims.

### **CONCLUSION**

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

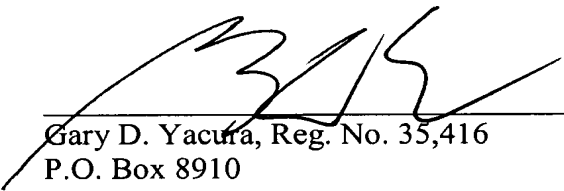
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura, Reg. No. 35,416, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By



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